

DEC 8 1995

No. 95-26

CLERK

IN THE  
SUPREME COURT OF THE UNITED STATES  
OCTOBER TERM, 1995

Herbert MARKMAN and POSITEK, Inc.,  
Petitioners,

vs.

WESTVIEW INSTRUMENTS, Inc.  
and ALTON ENTERPRISES, Inc.,  
Respondents.

On Writ Of Certiorari To The United States  
Court of Appeals for the Federal Circuit

BRIEF ON BEHALF OF THE  
AMERICAN AUTOMOBILE  
MANUFACTURERS ASSOCIATION  
AS AN AMICUS CURIAE  
IN SUPPORT OF THE RESPONDENTS

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### I. THE INTEREST OF AMICUS CURIAE

The American Automobile Manufacturers Association (AAMA) is a non-profit national trade association. Its member companies, Chrysler Corporation, Ford Motor Company, and General Motors Corporation, are principally engaged in the production and sale of motor vehicles.

The AAMA has no interest in which party prevails in this case. Its sole interest is in the law that this case may establish. Consent documents by both parties have been filed.

To compete effectively in the worldwide automotive market, the AAMA companies are heavily involved in technological development and the large financial investments needed to support that development. It is their view that decisions on when and how to undertake such investments cannot be made rationally without the assurance of a principled resolution of disputes concerning patents, and a consequent ability to determine effectively, generally without recourse to expensive litigation and unpredictable risks, the extent of existing patent rights. Hence, the AAMA supports the decision of the Court of Appeals for the Federal Circuit in this case holding that the construction of patent claims must be undertaken by a court trained in construing documents as a matter of law.

### II. THE CERTIFIED QUESTION

Unlike patents in the 18th century, today's patents are required by the Patent Act to contain claims that set the metes and bounds of the patent grant. As a consequence, although the question certified in this case refers to "genuine factual disputes about the meaning of a patent," rather than, the "meaning of the **claims** of a patent," we understand the question to have reference specifically to the "claims" of a

patent. Also, the reference to "genuine factual disputes" should not becloud the fact that the inquiry in this case concerns the construction or interpretation of the words of a government grant.

### III. SUMMARY OF ARGUMENT

In facing the issue of patent claim construction, one must be mindful that uncertainty and unpredictability inhibit needed investments in technology and encourage baseless suits. Principled claim construction, on the other hand, especially at an early phase of a complex patent suit, will foster settlement, streamline trials and promote efficient use of judicial resources.

The law appears to be settled, and the parties appear to be in agreement, that when the construction of a patent claim is clear from the basic documents that comprise the patent and its prosecution history before the Patent and Trademark Office, the issue of claim construction is for the court. The district court and ten of the eleven participating judges on the Court of Appeals found the meaning of the disputed word -- "inventory" -- to be clear from the Markman patent and its prosecution history. If this ruling is adopted, it may not be appropriate for the Court to undertake a review of the Constitutional issue that may arise when extrinsic evidence is required and that evidence projects a genuine dispute as to the meaning of a technical word to persons skilled in the relevant field.

If the Constitutional issue is addressed, care must be exercised not to treat all forms of extrinsic evidence the same. Some such evidence is merely testimony guiding the court through the basic documents, or opinion testimony as to the meaning of a phrase, or entire claim, without any first-hand testimony or other evidence of the meaning of a word in the relevant technology at the relevant time. Also,

extrinsic evidence may involve only grammatical construction, or the meaning of non-technical words, or evidence that contradicts the patent or its prosecution history. Only evidence concerning the meaning of a word of a claim to those skilled in the relevant technology at the relevant time -- which is less common than other forms of extrinsic evidence -- can raise a significant question as to a Seventh Amendment right to a jury trial concerning claim construction. We believe, however, that that question must be answered in the negative.

While the issue of patent infringement, in a suit for money damages, may well be for the jury, the same does not follow for all of the issues in suit. As this Court has held, it is the nature of the issue, rather than the nature of the overall action, that determines the right to a jury trial.

To place the issue in its proper perspective we are here dealing with a government grant that is defined by words, specifically the words of a patent claim. Under a Congressional mandate, and the delegation of Congressional power to reward inventors, the rights-defining words of the claim have been examined by the Patent and Trademark Office and found to be patentable in substance and sufficiently clear in expression.<sup>1/</sup>

Turning to the case law in England in 1791, which is determinative of the right to a jury trial "preserved" by the Seventh Amendment, we find no parallel or analogy to modern patent claim construction in the English patent cases. At that time, claims were not employed to define the scope of a patent. Rather, fact findings were involved, first to

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<sup>1/</sup>For convenient reference, a patent grant, which encompasses the scope-defining claims is included in an Appendix 2. It illustrates that the grant issues in the name of the United States of America. See 35 U.S.C. § 153.



determine what subject matter in the specification of a patent was new, by a comparison of the description in the specification with the prior art of record, and second to determine whether infringement was present, by determining whether the accused device was the same as, or a colorable variation of, the subject matter found to be new. Today, claim construction is not such a factual test of sameness, but a judgmental assessment of the meaning of a word-defined government grant.

Rather than the early English **patent** cases, the closest analogy in the 18<sup>th</sup> century English cases is to be found in the construction or interpretation of government grants -- particularly government grants defined by words. One example was patents for land or land grants, and there are others. The construction of such grants was the province of the court.

Patents in the U.S. have on infrequent occasions resulted from direct Congressional enactments. There can be little doubt that, as in the case of other legislation, the scope of such patents must be construed by the court as a matter of law. Under the current Patent Act, Congress has delegated this legislative function to the Patent and Trademark Office (PTO), with specifically prescribed qualifying standards, and a mandate as to the manner in which the grant is to be defined.

Whether this legislative function is exercised directly by Congress, or through a proper and circumscribed delegation to the PTO, the construction of the resulting government grant must be a matter of law for the court -- as was true of the construction of government grants in England in 1791 -- using whatever assistance the court may find helpful to inform itself as to the meaning of words and the general nature of the relevant technology.

#### IV. ARGUMENT

##### **A. The Public Interest in Patents, and the Major Influence of Patents on Industrial Growth, Require that Patent Disputes be Decided on a Principled and Predictable Basis**

Since patent claims fix the boundary between proprietary rights and the public domain, the proper, consistent and predictable construction of such claims is critical to the rapid and fair advance of technological development. So long as claim scope is uncertain and unpredictable, investors must be wary and technological advance will suffer.

Modern automotive production plants in the United States require an investment of a billion dollars or more. And the same is true in other industries. Such an investment may be expected to face the risks of an economic downturn and other business factors, but it should not have to face the prospect of being at sea concerning how the claims of existing patents are likely to be construed.

If the investments that keep the advance of technology churning, and provide the fuel for U.S. industries to compete effectively, cannot be made in reliance on a principled and predictable resolution of patent rights, the only safe course will be to plot a wide course around any existing patent claims, with the attendant inability to use what is truly in the public domain. As this Court stated in *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236, 63 S.Ct. 165, 170 (1942):

A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage inven-

tion only a little less than unequivocal foreclosure of the field.

To the same effect is *Brooks v. Fiske*, 56 U.S. (15 How.) 212, 215 (1853); *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369, 58 S.Ct. 899, 902 (1938).

Uncertainty also undermines confidence in the patent system, and fans the fires of baseless suits. With the potential returns high in a patent suit, a patent owner need only survive summary proceedings to be able to roll the dice before an untrained, and generally overwhelmed, jury. Principled and predictable claim construction by the court can weed out baseless suits. Also, such claim construction can occur early in a litigation, once both sides have had an opportunity to determine the nature of the accused subject matter. Consequently, it will foster settlement, streamline trials and promote an efficient utilization of judicial resources.

In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 147-8, 109 S.Ct. 971, 975-6 (1989), this Court observed the careful balance that exists, under the law governing patents, between proprietary rights and those that are free to all. The Court quoted from the writings of Thomas Jefferson that:

... from the outset, federal patent law has been about the difficult business "of drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not." 13 Writings of Thomas Jefferson (Memorial ed. 1904), at 335.

In today's patent system it is the claims of a patent that draw this line. *McClain v. Ortmyer*, 141 U.S. 419, 424, 12

S.Ct. 76, 77 (1891); *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339, 81 S.Ct. 599, 601 (1961).

Some of the arguments opposing the Court of Appeals' ruling in this case sound in public policy, but they are generally addressed to the cherished status of the Seventh Amendment, and its asserted applicability to all factfinding, rather than the desirability *vel non* of having a lay jury determine the meaning of words in the modern world of complex technology. Indeed, it would be difficult to imagine a sound public policy that would favor giving to a jury an issue of determining the meaning of technological terms that may be too complex for a judge, with no real opportunity to redress errors. In any event, however, the public policy issue has been resolved by Congress. Having the power to do so, Congress has declined to provide in the Patent Act that the construction of patent claims is for the jury.

Thus, the issue is drawn. There is no legislative mandate for a jury trial on patent claim construction, and consequently this issue is for the court unless the Seventh Amendment compels its resolution by the jury.

**B. When the Meaning  
of a Patent Claim is Clear  
from the Claims of the Patent, the  
Patent Specification and its  
Prosecution History, Claim  
Construction is an Issue  
of Law for the Court**

As the majority opinion of the Federal Circuit in this case has observed, the Patent Act provides that a patent shall conclude with one or more claims that particularly point out and distinctly claim the subject matter that an applicant for



a patent regards as his or her invention. 35 U.S.C. § 112, ¶ 2.

Moreover, the rules of the Patent and Trademark Office (PTO), which have the effect of law, provide that:

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. 37 CFR 1.75(d)(1).

Also, in relation to the prosecution of patent applications before the PTO, its rules provide that:

All business with the Patent and Trademark Office should be transacted in writing. ... The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt. 37 CFR 1.2

These provisions are part of a congressional plan that began with the Patent Act of 1836, which, for the first time in any country, established a Patent Office, and provided a systematic examination process for the evaluation of applications for patents. Patent Act of July 4, 1836, c. 357, 4 Stat. 577. The 1836 act was intended to curb the abuses of granting patents without any real screening. See Senator Ruggles report to the Senate, April 28, 1836, reprinted in J. of the Pat. Office Society, Vol. 18, No. 7, pp. 92-94 (1936).

The 1836 Act was also the first Patent Act that made reference to claims, saying that the inventor "shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery". Section 6, 1836 Patent Act, *supra*. The effect was to place on the Patent Office the responsibility of ascertaining the scope of the invention and seeing that its boundaries are properly defined in words. *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. (5 Otto) 274, 278 (1877). Thereafter, the 1870 Patent Act made clear that a patent must include **claims to define the scope of the patent grant**. It provided that the inventor "shall particularly point out and distinctly claim" his invention or discovery. Section 26, Patent Act of July 8, 1870, c. 230, 16 Stat. 198.

Similarly, in England in 1791 there was no statutory requirement for patent claims, and no examination of patent applications. Instead, a jury had to sort through a patent granted without examination to determine what was new and what was old, and then determine whether the accused device was the same as, or a colorable variation of, what was found to be new. See the cases quoted in the accompanying Appendix 3, *infra*. British patents were first required to contain claims in 1883, by the Patents Designs and Trade Marks Act of 1883.<sup>2/</sup>

In contrast to the situation in England and the U.S. in 1791, we now have patent claims. The Patent Act now

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<sup>2/</sup>Section 5 of the U.K. Patents Act of 1883, in pertinent part, was as follows:

(5). A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

requires that the PTO ensure that the claims allowed an applicant are unambiguous, that they meet other requirements, and that they do not encompass the earlier inventions of others or other prior art. 35 U.S.C. §§ 102, 103 & 112; *Graham v. John Deere Company*, 383 U.S. 1, 86 S.Ct. 684, (1966). This process results in a **governmental grant** of exclusivity, namely, the right to exclude others from operating within specified borders, **the scope of which is fixed by the words of the allowed claims.** *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. at 339, 86 S.Ct. at 601.

Thus, as will be discussed, whatever may have been the role of the jury under the different patent system that existed in 1791, both in England and in this country, the present-day patent system mandates that a patent contain rights-defining claims. Those claims being a government grant, it is for the Court to construe them as an issue of law -- the construction being performed with the aid of certain basic documents comprising the patent and its prosecution history, and any useful extrinsic evidence.<sup>2</sup>

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<sup>2</sup>See, e.g., *Hogg v. Emerson*, 47 U.S. (6 How.) 436, 485 (1848) (The true rule of construction in respect to patents and specifications, and the doings generally of inventors, is to apply to them plain and ordinary principles, as we have endeavored to on this occasion, ...); *Silsby v. Foote*, 55 U.S. (14 How.) 218, 225 (1853) (The construction of the claim was undoubtedly for the court.); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 338 (1853) (The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them.); and the other authorities cited in the opinion below. *Markman v. Westview Instruments*, 52 F.3d 983, 977-8 (Fed. Cir. 1995).

The parties and the Court of Appeals appear to agree that patent claim construction is for the court when the meaning of the patent claim is clear from the basic documents.

In this regard, we note that the opinions expressed by ten of the eleven judges of the Court of Appeals who participated in the decision in this case, as well as that of the district court, held that the meaning of the disputed term "inventory" is clear from the basic documents, namely, the Markman patent and its prosecution history, as follows:

In this case, as fully discussed above, *the patent and prosecution history make clear* that "inventory" in claim 1 includes in its meaning "articles of clothing. ... based on the patent and prosecution history, that the claim term "inventory" means articles of clothing. (Emphasis added.) (*Markman* majority, 52 F.3d, at 983)

\* \* \* \*

Close examination of these cases, however, reveals that, *like the one before us today*, interpretation of the claims at issue before the deciding court *presented no real factual question*. (Emphasis added.) (*Markman*, J. Mayer concurrence, 52 F.3d, at 993)

\* \* \* \*

In this case, *the claims, specification, and prosecution history irrefutably show* that case transaction totals are not "inventory." (Em-



phasis added.) (*Markman*, J. Rader concurrence, 52 F.3d, at 998)

While, as an amicus, we decline to address the issue of the clarity of the basic documents to define the word "inventory", since this principally affects the parties, we agree with the view of the judges of the Court of Appeals, as well as the parties and the case law, that if the meaning of a patent claim is clear, from a review of the patent and its prosecution history before the PTO, construction of the claim is solely an issue of law for the court.

Also, we note that if such clarity exists in this case, it may be inappropriate for the Court to reach the Seventh Amendment constitutional issue in its review of the Court of Appeals judgment. *Rescue Army v. Municipal Court of Los Angeles*, 331 U.S. 549, 568-570, 67 S.Ct. 1409, 1419-1420 (1947).

### **C. Different Types of Extrinsic Evidence Concerning Patent Claims Require Different Consideration**

Before discussing the question of the proper role of the court and jury in construing patent claims when extrinsic evidence is required and introduced, we note that it would be a mistake to treat all forms of extrinsic evidence the same. By extrinsic evidence we mean anything that is extrinsic to the basic documents, which are the patent at issue and its prosecution history. It must be recognized that extrinsic evidence can, and in patent cases often does, fall into at least the following distinct categories.

### **1. A Guiding Hand**

Such evidence may take the form of guiding testimony of a technical expert or patent expert, leading the court through the patent and its prosecution history in order to earmark the portions thereof that are believed to be relevant to a proper construction of the claims. Such testimony is not uncommon, and while it may be helpful, it cannot lessen the obligation of the court to construe the claims as a matter of law.

### **2. Opinion Testimony**

Another common form of extrinsic evidence is the opinion testimony of experts, based on their expertise in the field, as to how a word or phrase of a claim, or an entire claim, should be construed -- without supporting evidence as to the accepted meaning of a word in the claim, in the relevant field at the relevant time. This testimony, in effect, states merely how each expert would construe the claim if he or she were the judge, or at least how he or she proposes that the court or jury do so. Such testimony is to be distinguished from testimony by a witness based on first-hand knowledge, or relevant contemporaneous publications, concerning the accepted meaning of a word in a claim in the relevant field at the relevant time -- namely at the time the application for the patent was filed. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556 (Fed. Cir. 1983). This opinion testimony is but a legal conclusion that cannot lessen the court's obligation to construe the claims as a matter of law. *Johnston v. Ivac Corp.*, 885 F.2d 1574, 1579-80 (Fed. Cir. 1989); *Becton Dickinson And Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 797 (Fed. Cir. 1990).

3. **Evidence that Creates a Dispute as to Words or Phrases that are Unassociated with the Relevant Technology, or that Concern Grammatical Construction**

This same rule should apply when the meaning of the words of a claim are in dispute, when the dispute involves only their ordinary meaning, unassociated with any particular technology, or when the dispute involves only punctuation or grammatical construction. The resolution of such disputes appears to be clearly the province of the court.

4. **Evidence that Conflicts with the Patent or its Prosecution History**

Extrinsic evidence may also take the form of evidence of claim meaning that is contrary to the specification or prosecution history -- but such evidence similarly cannot present a fact issue for the jury. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387 (Fed. Cir. 1992); *Southwall Technologies v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995).

5. **Evidence concerning the Relevant Historical Meaning of a Word**

A different analysis may be required when the extrinsic evidence concerns the historical meaning of a word in the relevant technology, namely, first-hand testimony or documentary evidence of what a particular word in a patent claim meant in the relevant field at the time the application for the patent was filed. *Gore v. Garlock*, *supra*. If such evidence is not in conflict with the basic documents, since a meaning established by those documents prevails over the normal meaning in the field, *Southwall v. Cardinal*, *supra*,

and if a genuine dispute is presented by the evidence, a serious question as to the right to a jury trial is presented. Nevertheless, for reasons that will be discussed, we believe that even in this situation the extrinsic evidence is properly subsumed in the legal claim construction process.

Before leaving this point, we note that this discussion concerns the meaning of a "word" in the claim, rather than a phrase. It would equally be true where a phrase is involved, in the relatively few instances in which a phrase had a particular meaning in the field at the relevant time. More likely, however, when a phrase is involved, the contest is a grammatical one, namely, interpreting the construction of several words used in a particular pattern, the meaning of each of which is known. This appears to be clearly the province of the court.

In short, in considering the issue of extrinsic evidence, it is not appropriate to treat all such evidence with a broad brush. The question of a right to a jury trial is raised most squarely in relation to conflicting evidence concerning the historical meaning of a word in the claim, that is, testimony based on first-hand knowledge, or documentary evidence, concerning how a word in the claim was actually used, and understood, in the particular technology at the time in question.

As will be discussed, however, it is the view of this amicus that there is no Seventh Amendment right to a jury trial even as to this extrinsic, historical evidence.

**D. There is No Seventh Amendment Right To a Jury Trial for the Construction of a Patent Claim Even When Extrinsic Evidence of a Historical Meaning is Required and Introduced**

Turning to the issue of whether the Seventh Amendment gives rise to the right to a jury trial for the construction



of a patent claim when extrinsic evidence of the historical meaning of a word is required and introduced, as far as we have been able to discern, this is an issue of first impression for this Court.<sup>4/</sup>

We note first that the Seventh Amendment provides that "[i]n Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved..." The term "preserved" speaks as of the year the Seventh Amendment was ratified, in 1791, and, as this Court has held, it relates to the law in the English courts at that time. *Tull v. United States*, 481 U.S. 412, 417, 107 S.Ct. 1831, 1835 (1987). The reference to "Suits at common law" concerns "'suits in which legal rights [are] to be ascertained and determined, in contradistinction to those where equitable rights alone [are] recognized, and equitable remedies [are] administered.'" *Chauffeurs, Teamsters and Helpers Local No. 391 v. Terry*, 494 U.S. 558, 564, 110 S.Ct. 1340, 1344 (1990). This includes "causes of action created by Congress," *Chauffeurs*, 494 U.S. at 564-565, 110 S.Ct. at 1344, including patent causes, *Root v. Railway Co.*, 105 U.S. 189 at 206-207 (1881).<sup>5/</sup>

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<sup>4/</sup>As mentioned previously, the Court need not reach this issue if it concludes that the meaning of the disputed claim word -- "inventory" -- is clear from the patent and its prosecution history.

<sup>5/</sup>The statutory cause of action in this case is a "civil action for infringement" of a patent. 35 U.S.C. § 281. A patentee is granted the "right to exclude others from making, using, or selling the invention..." and, in the case of process claims, "the right to exclude others from using or selling in the United States, or importing into the United States," (continued...)

In *Ross v. Bernhard*, 396 U.S. 531, 538, 90 S.Ct. 733, 738 (1970), the Court ruled that the right to a trial by jury depends on the nature of the issue to be tried, rather than the character of the overall action. To resolve that right for a particular issue, the Court requires a two-step examination, first, of the nature of the issue and, second, of the remedy sought. *Chauffeurs*, 494 U.S. at 565, 110 S.Ct. at 1344. While the Court has held that the second prong of this two-part test is the more important, *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42, 109 S.Ct. 2782, 2790 (1989), since legal damages were sought in this suit, only the first prong need be considered.

As the issue here is the construction of a patent claim when extrinsic evidence of the historic meaning of one or more words in the claim is required and introduced, this

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<sup>2/</sup>(...continued)

products made by that process." 35 U.S.C. § 154. Section 281 vindicates those rights by giving to the patentee the "remedy" of "civil action for infringement of his patent." Sections 283 (injunctions), 284 (damages adequate to compensate for the infringement) and 285 (attorney fees) provide the forms of relief that are available to the patentee pursuant to that remedy. Only damages are mandated ("shall award"). The grant of an injunction is discretionary ("may grant ... principles of equity"), *Roche Products v. Bolar Pharmaceutical Co.*, 733 F.2d 858, 865 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 856, 105 S.Ct. 183 (1984), as is the award of reasonable attorneys fees ("may"), *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 629 (Fed. Cir. 1985), *cert. denied*, 474 U.S. 976, 106 S.Ct. 1640 (1985). The same right/remedy/relief trilogy has been present since the first patent statute, in 1790, with varying limitations on the forms of remedy and relief.

issue must be compared to the most closely analogous 18th-century counterpart in England. *Tull v. United States*, 481 U.S. at 417, 107 S.Ct. at 1835.

As already noted, in 1791 patents in England were not required by statute to contain claims. Thus, there was no direct parallel in England in 1791 to the issue of construing a patent claim. Rather, as already noted, a resolution of the issue of infringement in England at that time required the jury to sort out what in the specification was new, from that which was old, and determine whether the accused device was the same as the new device, or a "mechanical equivalent" or "colourable variation" thereof. See the cases quoted in the Appendix 3 hereto, *infra*. This process involved factual determinations. The specification was compared with the prior art of record to determine what was new, and the elements or apparatus thus determined to be new were compared to the accused apparatus.

There are thus two factors that are relevant here. First, the process followed in the 1791 infringement analysis in England does not provide an analogous issue to today's claim construction, and, second, in addition to the lack of any direct analogy, the nature of the determinations is different -- one being a factual determination of sameness, as compared to the prior art and to the accused device -- while the other is a judgmental construction of a definitive expression of the metes and bounds of a particular type of government grant. See 3 Patent Law Perspectives, § 7.6 [2.-2], pp. 7-228.47-.48.

The petitioner cites early English cases for the view that English juries were instructed to decide questions that required them to interpret terms of art in patents, citing *Arkwright v. Nightingale*, Davis Patent Cases 37 (Common Pleas 1785); and *Turner v. Winter*, 1 T.R. 602, 605 (K.B. 1787). Significantly, in neither of these cases was there a dispute over the meaning of any words in the specification of

the patent in suit. The opinion in the *Turner* case, for example, sets forth the relevant portion of the specification. There is no indication that the meaning of any of the words in the quoted portion of the specification was in dispute. Instead, not all of the disclosed fossil salts were found to work; indeed, only one such salt, "sal gem", was found to work. A question arose, therefore, whether the specification was calculated to mislead by its reference to fossil salts generally.

Later cases in England are more enlightening, but it is not clear that they reflect the law as of 1791. *Neilson v. Harford*, 8 M & W 806, 1 Webster Patent Cases 295, 151 E.R. 1266 (Exch. of Pleas 1841); *Hill v. Evans*, 4 De G.F. & J. 288, 45 E.R. 1195 (Ch. 1862). In the *Neilson* case, the court, rather than the jury, interpreted the word in the specification that was in question -- "effect" -- but the court suggested the following general rule:

Then we come to the question itself, which depends on the proper construction to be put on the specification. It was contended that of this construction the jury were to judge. We are clearly of a different opinion. The construction of all written instruments belongs to the Court alone, whose duty it is to construe all such instruments, as soon as the true meaning of the words in which they are couched, and the surrounding circumstances, if any, have been ascertained as facts by the jury: and it is the duty of the jury to take the construction from the Court, either absolutely, if there be no words to be construed as words of art, or phrases used in commerce, and no surrounding circumstances to be ascertained; or conditionally, when those words or circum-



stances are necessarily referred to them. Unless this were so, there would be no certainty in the law; for a misconstruction by the Court is the proper subject, by means of a bill of exceptions, of redress in a Court of Error; but a misconstruction by the jury cannot be set right at all effectually. *Neilson v. Harford*, 151 E.R. at 1273

This rule was restated in *Hill v. Evans*, 45 E.R. at 1197, a suit in equity.

Assuming therefore that in resolving the issue of novelty or infringement in England in 1791, by comparing the described device with the prior art or the accused device, the jury was left to determine the meaning of disputed technical terms in the description, that determination has little to do with construing the words of a patent claim, which, in today's patent system, is a **definitive government grant**. Rather, a closer parallel to a government grant defined by a patent claim is the interpretation in the English cases in 1791 of government grants by parliament or the Crown.

The cases make clear that the construction of early government grants was an issue of law for the court. In *United States v. King et al.*, 48 U.S. 833 (7 How.) (1849), while neither party demanded a jury trial, *Id.*, at 844, the Court held that the construction of a land grant is a question of law to be decided by the court. *Id.*, 847. See, also *Schulenberg v. Harriman*, 88 U.S. (21 Wal.) 44, 62 (1874) ("A legislative grant operates as a law as well as a transfer of the property, ..."). Also, in the case of *United States v. Arredondo*, 31 U.S. (6 Pet.) 691 (1832), the land grant provided that proceedings concerning it were to be undertaken according to the rules of a Court of equity, and there was no Seventh Amendment challenge to this provision.

In *Missouri, Kansas And Texas Ry. Co. v. Kansas Pacific Ry. Co.*, 97 U.S. 491, 497 (1878), the Court stated in reference to land grants that:

It is always to be borne in mind, in construing a congressional grant, that the act by which it is made is a law as well as a conveyance, and that such effect must be given to it as will carry out the intent of Congress. That intent should not be defeated by applying to the grant the rules of the common law, which are properly applicable only to transfers between private parties.

To the same effect is *Winona & St. Peter RR. Co. v. Barney*, 113 U.S. 618, 625 (1884) and *Wisconsin Central R'D Co. v. Forsythe*, 159 U.S. 46, 55 (1895).

And in *Leavenworth R.R. Co. v. U.S.*, 92 U.S. 733, 740 (1875), the Court ruled that:

All grants of this description are strictly construed against the grantee; nothing passes but what is conveyed in clear and explicit language ...

\* \* \* \*

If these terms are plain and unambiguous, there can be no difficulty in interpreting them; but, if they admit of different meanings, -- one of extension, and the other of limitation, -- they must be accepted in a sense favorable to the grantor. ... In other words, what is not given expressly, or by necessary implication, is withheld.

To the same effect is *Charles River Bridge v. Warren Bridge*, 36 U.S. (11 Peters) 420, 543-4 (1837); and the recent patent case of *Genentech, Inc. v. Wellcome Foundation Ltd.*, 29 F.3d 1555, 1564-5 (Fed. Cir. 1994).

Government grants that convey land or other benefits are thus subject to the same rules of interpretation as other statutes. 3 Sutherland Statutory Const. (4th Ed), § 63.01, at 134. The case of *The Attorney General v. The Cas:-Plate Glass Company*, 1 Anst. 39, 145 E. R. 793, 795 (1792) indicates how statutes were being construed in England circa 1791 in relation to the interpretation of the word "square" as used in the trade. In this case, the Court stated that:

In explaining an act of parliament, it is impossible to contend, that evidence should be admitted; for that would be to make it a question of fact, in place of a question of law. The judge is to direct the jury as to the point of law, and in doing so, must form his judgment of the meaning of the legislature in the same manner as if it had come before him by demurrer, where no evidence could be admitted. Yet on demurrer, a Judge may well inform himself from dictionaries or books on the particular subject concerning the meaning of any word. If he does so at Nisi Prius, and shews them to the jury, they are not to be considered as evidence, but only as the grounds on which the Judge has formed his

opinion, as if he were to cite any authorities for the point of law he lays down.<sup>82</sup>

Turning to patents for inventions, we note that the power of Congress to grant patents stems from Article I, Section 8, of the Constitution, which grants to Congress the power to "promote the progress of science and useful arts, by securing for limited times to authors and inventors the

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<sup>82</sup>The amicus brief filed on behalf of Litton cites cases for the view that the interpretation of the words of statutes is for the jury, but in those cases the jury decided only the application of the statutes to the facts, rather than construing the terms of the statute. *U.S. v. Gaudin*, \_\_\_ U.S. \_\_\_, 115 S.Ct. 2310 (1995) (the meaning of the statutory word "material" is an issue of law); *TSC Industries, Inc. v. Northway, Inc.*, 426 U.S. 438, 96 S.Ct. 2126 (1976) (same); *Chandris, Inc. v. Latsis*, 115 S.Ct. 2172 (1995) (the same as to the word "seaman"); *McDermott International Inc. v. Wilander*, 498 U.S. 337, 111 S.Ct. 807 (1991) (the same as to "Member of the crew"): In these cases, this Court stated that:

Because statutory terms are at issue, their interpretation is a question of law and it is the court's duty to define the appropriate standard.

*Chandris*, 115 S.Ct. at 2190.

"Member of a crew" and "seaman" are statutory terms; their interpretation is a question of law.

*McDermott*, 498 U.S. at 356, 111 S.Ct. at 818.



exclusive right to their respective writings and discoveries." This Court has held that this clause is limited in the respect that the exclusive rights that Congress grants must be "to promote science and useful arts", *Graham v. John Deere Company*, 383 U.S. 1, 5; 86 S.Ct. 684, 687 (1966), *Bonito Boats v. Thunder Craft Boats*, *supra*, but the manner in which this Congressional power is to be exercised is generally said to be unrestricted. *Blanchard v. Sprague*, 3 F.Cas. 648, 3 Sumn. 535, 2 Story, 164 (Cir. Ct. D. Mass. 1839). Thus, it has been held that Congress could itself grant patents as private enactments. See *Evans v. Eaton*, 3 Wheat (16 U.S.) 454 (1818); *Bloomer v. Stolley*, 3 F.Cas. 729, 5 McLean 158, 8 West. Law J. 158 (Cir. Ct., D. Ohio 1850). In the *Bloomer* case, the Court stated that:

There would seem to be no doubt that the constitutional power in question might have been fully exercised by congress in making special grants; this might have engrossed much of the time of congress, and it might not be thought the most competent body to investigate the facts and do equal justice to inventors; but this would be a question of expediency, and not of constitutional power.

There would also seem to be no doubt that the construction of the grant of such an enactment is a matter of law for the court. *Evans v. Eaton*, *supra* (albeit the Court was not dealing with a definitive patent claim).

Since 1836 Congress has delegated its legislative power to grant patents to the Patent and Trademark Office. Today the grant can only be made by a definite recitation in the form of a patent claim that sets the boundaries of the grant, in keeping with a detailed statutory framework. Moreover, Congress retains oversight responsibility and the

power, within Constitutional limits, to prescribe the standards and the nature and duration of the grants.

Whether a patent is issued by direct Congressional enactment, or indirectly through the offices of the PTO acting under standards and guidelines set by Congress, exercising the power delegated to it by the legislature, a determination of the scope of the grant delimited by the words of a patent claim must remain a question of law for the courts. This is particularly true since the metes and bounds of the grant -- according to which the application for it has been tested and allowed -- is fixed by the words of the claims.<sup>2/</sup>

### E. Other Factors

It has been asserted that Congress does not have the power to abrogate the Seventh Amendment right to a jury trial. We agree. Thus, assuming that a right existed in England in 1791 for the jury to determine from the specification of a patent what is old and what is new, and to compare the new portion to the accused device, Congress could not interfere with that jury trial right if it had maintained that mode of deciding patent cases. For a detailed discussion, see

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<sup>2/</sup>This is not to say that a patent is merely analogous to a statute. Nor is it the view of this amicus that a patent can never be viewed as being analogous to a contract or deed for some purposes, although we recognize that the logic of analogy is a minefield. Rather, it is the position of this amicus that a few patents have been granted by statutes, not merely analogous to statutes, and that whether in fact created by statute or the exercise of power delegated by Congress, patent claims constitute government grants in words -- the meaning of which is an issue of law for the court.

3 Patent Law Perspectives, p. 7-228.48. Congress does have the power, however, to change the nature of a patent grant, either to make specific grants through its own enactments, or to delegate that authority, as it has done, to an administrative agency under a legislative command to grant patents having definitive, rights-defining claims. 35 U.S.C. § 112, ¶ 2. Either way, the construction of a patent grant, whether made through direct Congressional enactment or by its delegation, should be construed in accordance with the manner in which government grants of specifically-defined rights were construed in England in 1791 -- by the court as a matter of law.

To be sure, Congress could have specified in the current Patent Act that the construction of a patent claim is for the jury -- even though not compelled to do so by the Seventh Amendment. But, unlike the 1790 Patent Act, which specifically relegated certain issues to the jury, the current Patent Act contains no such provision.

It has also been asserted that a jury is an appropriate vehicle for construing patent claims because juries do the "right thing." However much the communal experience of jurors may lend itself to an assessment of the facts and the application of such facts to a standard of reasonable care, as in a negligence action, there is no communal experience or insight that jurors bring to a construction of a patent claim or to an understanding of the arcane nuances of patent law or patent documents. Thus, after a litany of instructions that would numb the mind even of one steeped in patent law, the jury is set adrift to determine what one or two, or a hundred, patent claims may mean as they are used in an abstruse area of modern technology. And no one can predict what the result might be until the jury returns.

Further, it has been asserted that the Court of Appeals is not an appropriate forum in which to determine the scope of a patent claim. It is unclear, however, why a district

court cannot develop an appropriate record, and set forth the basis for its ruling on claim construction -- so that the ruling can be effectively reviewed on appeal. That this may require appropriate handling at the trial level is something that the district courts have successfully faced in many other contexts. As this Court ruled in *Dairy Queen v. Wood*, 369 U.S. 469, 478 (1962), a special master might be employed, under Rule 53, Fed. R. Civ. P., where appropriate. That a complex interpretive issue can be avoided by passing it to the jury is not a sufficient reason for relieving the district courts, and subsequently the Court of Appeals, of their obligation to resolve this issue.

The alternative is to leave claim construction to the jury, with no effective review so long as there is substantial evidence to support its ruling -- right or wrong -- and with a potential for different constructions by different juries, none of which, if supported by substantial evidence, can be corrected on appeal. In contrast, a government grant circumscribed by words that are required by statute to be definite must have one meaning. There must be uniformity. Difficult or not, it must be for the court to declare that meaning as a matter of law.<sup>8/</sup>

It has also been asserted that the meaning of a word in a claim is what the word meant to one of ordinary skill in the relevant field at the relevant time -- and therefore it must be a task for the jury to determine who is a person of

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<sup>8/</sup>In the view of Sir Patrick Devlin, "Where there is need for uniformity a jury is no use." *Trial By Jury*, by Sir Patrick Devlin, Sweet & Maxwell Ltd., 1988, pp. 98-99.

The policy of uniformity is reflected by the act of Congress setting up the Court of Appeals for the Federal Circuit.



ordinary skill, en route to construing the claims. The fallacy of this assertion is twofold. First, in over forty years counsel for this amicus has never seen a case in which a word in a claim had a different meaning for those of ordinary skill in the field, as compare to those of lesser or greater skill. The closest one might come to this situation is where one person knows the meaning and another does not, or where one has a misconception of the meaning -- but these factors do not affect the accepted meaning in the field. Secondly, should such a rare situation exist, a court can secure from the jury an appropriate description of a person having ordinary skill in the field -- which is often stipulated - and then undertake the court's task of construing the claims.

One amicus asks how a court will be able to determine the meaning of the phrase:

"first electrical comparator connected to the load measuring means measuring the polished rod load relative to the present load point."

Aside from determining what in the specification corresponds to the claimed "means," as required by 35 U.S.C. § 112, ¶6, there is no word in this phrase that has a disputable meaning in the field. If the court needs to inform itself on the relevant technology, it should do so; it is not without the resources to do so. This can be done by scheduling one or more hearings, asking questions, requesting applicable documents that contain the standard definitions of terms, requesting the use of demonstrative aids, advising the parties where more enlightenment is needed, appointing a special master or a court-appointed expert, or whatever may be appropriate. Simply admitting testimony by experts for both sides, each of whom advocate the position of one of the parties, and passing the issue to the jury, can only produce

confusion. It will create artificial factual disputes when there is none, when the real issue is the legal construction of the grant that is defined such as by the above phrase.

Actually, the court will have to inform itself concerning the relevant technology even to be able to determine whether there is truly a genuine dispute concerning the meaning of the word, or merely one that has been manufactured by a paid expert.

Other examples of phrases containing technical words that present no real meaning dispute are presented by another amicus. They similarly show the irrationality of letting each party present an expert who will subscribe to a meaning that meets the needs of the party's case, and then laying on an overwhelmed jury the unenviable burden of making a choice -- when the real issue is the scope of a word-defined government grant.

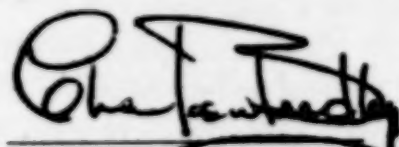
In short, the construction of a patent grant, as specifically defined in patent claims -- whether derived from a special act of Congress or through the power it has delegated to the PTO -- is properly an issue of law for the court.

## V. CONCLUSION

A principled and rational construction of the claims of a patent requires that claim construction be undertaken by the court, using all of the faculties available to it. This is particularly true when the meaning of the claim is clear from the basic documents, formed by the patent and its prosecution history, when the construction is based on the ordinary meaning of words, unassociated with any particular technology, or when it is based on punctuation or grammatical construction aside from technology. Moreover, claim construction should properly be an issue of law for the court even when extrinsic evidence is required and introduced

concerning the historical meaning of a particular word in a particular field on a particular date. A patent claim is a definitive government grant, and, as in the case of government grants in England in 1791, construction of that grant is properly for the court to decide as an issue of law.

Respectfully,



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## Appendix 1

### § 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. (Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat. 501; November 14, 1975, Public Law 94-131, sec. 5, 89 Stat. 691.)



**§ 103. Conditions for patentability; non-obvious subject matter**

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. (Added November 8, 1984, Public Law 98-622, sec. 103, 98 Stat. 3384.)

**§ 112. Specification**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (Amended July 24, 1965, Public Law 89-83, sec. 9, 79 Stat. 261; November 14, 1975, Public Law 94-131, sec. 7, 89 Stat. 691.)

#### **§ 153. How issued**

Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent and Trademark Office designated by the Commissioner, and shall be recorded in the Patent and Trademark Office. (Amended January 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

#### **§ 154. Contents and term of patent**

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of fees as provided for in this title, of the right to exclude others from making, using, or selling the invention throughout the United States and, if the invention is a process, of the right to exclude others from using or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof. (Amended July 24, 1965, Public Law 89-83, sec. 5, 79 Stat. 261; December 12, 1980, Public Law 96-517, sec. 4, 94 Stat. 3018; August 23, 1988, Public Law 100-418, sec. 9002, 102 Stat. 1563.)

#### **§ 281. Remedy for infringement of patent**

A patentee shall have remedy by civil action for infringement of his patent.

#### **§ 283. Injunction**

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

#### **§ 284. Damages**

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

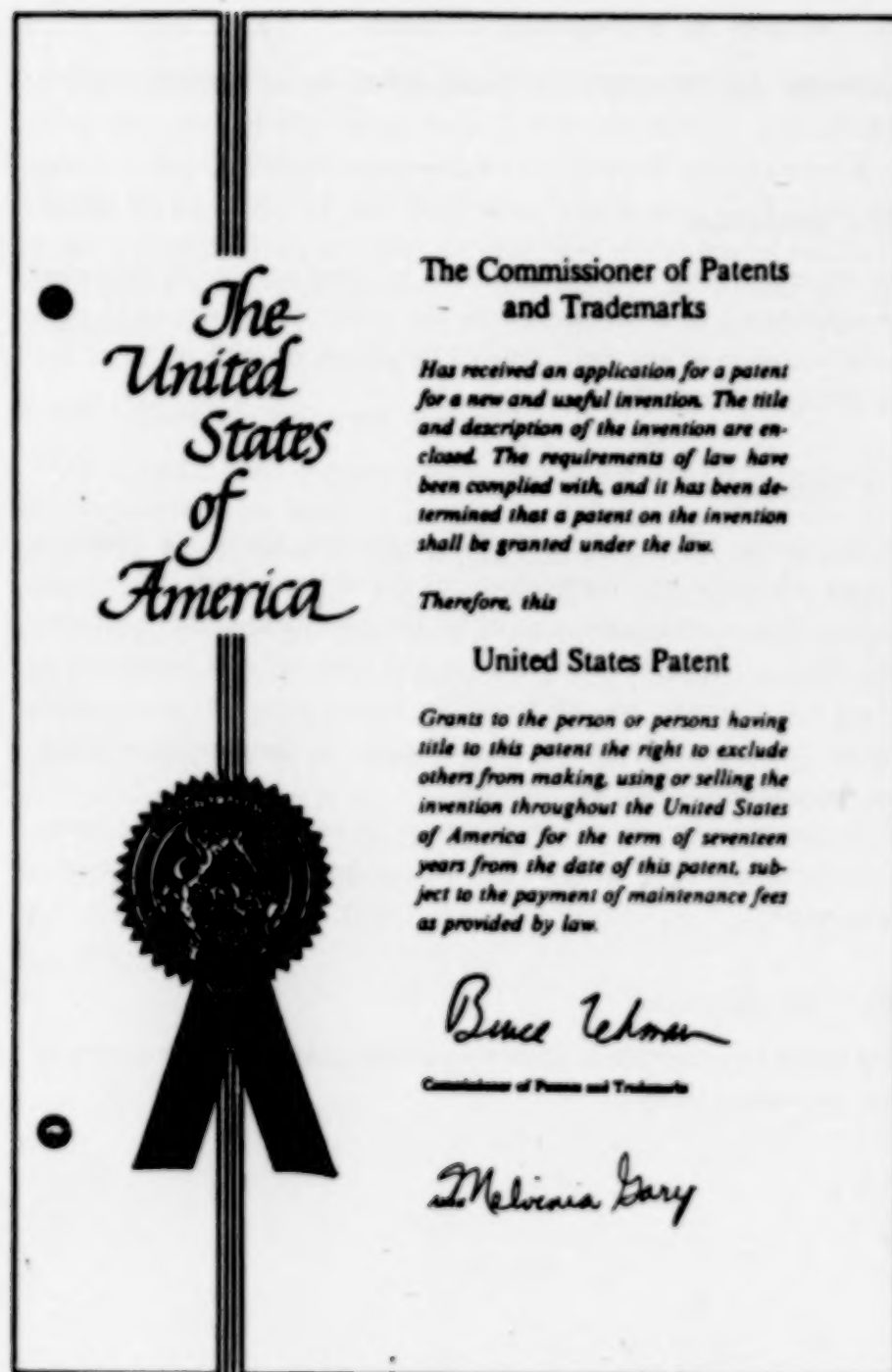
When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

#### **§ 285. Attorney fees**

The court in exceptional cases may award reasonable attorney fees to the prevailing party.





In *Bovill v. Moore* (C.P. 1816), available in John Davies, *A Collection of the Most Important Cases Respecting Patents of Invention and the Rights of Patentees* 361 (London 1816), tried in 1816 in the Court of Common Pleas, Lord Chief Justice Gibbs instructed the jury:

I remember that that was the expedient used by a man in Cornwall, who endeavored to pirate the steam-engine. He produced an engine, which, on the first view of it, had not the least resemblance to Boulton and Watt's: - where you looked for the head, you found the feet, and where you looked for the feet, you found the head; but it turned out that he had taken the principle of Boulton and Watt's -- it acted as well one way as the other; but if you set it upright, it was exactly Boulton and Watt's engine. So here, I make the observation, because I observe it is stated that one acts upwards, and the other downwards, one commences from the bottom and produces the lace by an upward operation, the other acts from above and produces it by an operation downwards; but that, if the principle be the same, must be considered as the same in point of invention. *Id.*, at 405-6.<sup>27</sup>

<sup>27</sup>It should be noted that the term "principle" is often defined by the early cases as meaning the "mode of operation," rather than some basic law of nature. *Burr v. Duryee*, 68 U.S. (1 Wal.) 531, 572-573 (1863); Curtis, *Law of Patents* § 306 n.1 (3rd ed. 1867).

In *Hill v. Thompson*, 150 Eng. Rep. 427 (Ex. D. 1818), the jury returned a verdict for the plaintiff and the defendant obtained a rule *nisi* to set the verdict aside or have a new trial. At the hearing, in 1818, of the rule to set aside the jury verdict, Judge Dallas delivered the judgment of the court, stating, in relevant part:

It is scarcely necessary here to observe, that a slight departure from the specification for the purpose of evasion only would, of course, be a fraud upon the patent; and, therefore, the question will be, whether the mode of working by the Defendant has or has not been essentially or substantially different. *Id.* at 434-5.

In *Webster v. Uther* (K.B. 1824), available in 1 Benjamin Vaughn Abbott, *Decisions on the Law of Patents for Inventions Rendered by English Courts Since the Beginning of the Seventeenth Century* 21 (Washington, Charles R. Brodix 1887) at 369, the invention was the addition of a bolt sliding or moving in a groove by which the roller magazine was then fixed in a percussion gun lock. The defendant's lock had a spring in the bolt. The jury heard evidence from machines that a spring in the bolt was the same thing as a bolt sliding in a groove, and found that the defendant had infringed.

In *Minter v. Wells* (Ex. 1834), available in 1 Thomas Webster, *Reports and Notes of Cases on Letters Patent for Inventions* 166 (London, A. Milliken and T. Clark 1841) (hereinafter "*Webster*") at 127, 1 William Carpmael, *Law Reports of Patent Cases* 1 (London, A. MacIntosh 1851) (hereinafter "*Carpmael*") at 622, tried in 1834 in the Court of Exchequer before Mr. Baron Alderson and a special jury,

the jury returned a verdict for the plaintiff after being charged:

If you are of the opinion that the plaintiff is the first and true inventor, that the invention is useful, and that he has given such a description in his specification as would make an experienced workman able to make the chair from it, there seems no doubt that the defendant's chair is an infringement of that patent, because undoubtedly it is a colourable variation, and a colourable variation only. There is a celebrated case which Mr. Justice Buller mentions, where a party produced a machine which at first sight appeared to be wholly different from that which was the subject of the patent; but when you came to consider it, all the difference was, that the head was where the tail should be, and the tail where the head should be; but they operated on the same principle; and so it is precisely here; both the parts are turned. 1 Webster, *supra* at 133-4, 1 Carpmael, *supra* at 639.

In *Morgan v. Seward*, (Ex. 1836), available in 1 Webster, *supra* at 170, 2 Carpmael, *supra* at 37, tried in 1836 in the same court before the same judge, the jury returned a verdict for the plaintiff after being charged:

I think, gentlemen, this case lies within a very narrow compass. The plaintiffs complain of the defendants for infringing their patent; the defendants make several defenses; the first that they did not infringe the patent. Upon the fact you have expressed your opin-

ion, that you have no doubt about it, that the one is an infringement of the other, the principle of which would be simply whether the defendants' machine either differed colourably, or only in those things which were mechanical equivalents, the one for the other. Now, I think when you are told what the plaintiffs' invention really is, you will see that those differences which Mr. Donkin and others pointed out as the differences between the one machine and the other, are, in truth, differences which do not affect the principle of the plaintiffs' patent at all. The two machines are alike in principle, and the one who made the first invention of that, suggested the principle to the other; though he may have carried it into effect by substituting one mechanical equivalent for another. You are to look to the substance, and not to the mere form. If in substance it is an infringement of it, you ought to find it so; but if you think that in substance it is not the same, if it was in principle really different, then you will find it not to be an infringement, though it might have a resemblance in its parts. 1 Webster, *supra* at 171, 2 Carpmael, *supra* at 89-90.